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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,940	10/21/2005	Ulrich Deuschle	BB-137	7569
23557 7590 03/14/2007 SALIWANCHIK LLOYD & SALIWANCHIK A PROFESSIONAL ASSOCIATION PO BOX 142950 GAINESVILLE, FL 32614-2950			EXAMINER CHENG, KAREN	
			ART UNIT	PAPER NUMBER
			1626	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/14/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/526,940

Applicant(s)

DEUSCHLE ET AL.

Examiner

Karen Cheng

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 22 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,9-11 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7,8 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

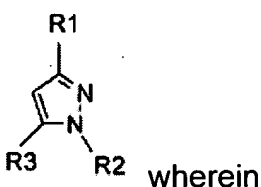
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|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/20/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-27 are currently pending in the instant application. Claims 5-6, 9-11, 15-17 are withdrawn from consideration as being drawn to non-elected subject matter.

Response to Election/Restrictions

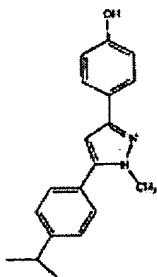
Applicant's election of a Group drawn to a compound of formula (I)



R₁ is substituted phenyl or C₅ to C₆ substituted heteroaryl;

R₂ is H, C₁ to C₈ alkyl, C₁ to C₈ substituted alkyl, C₁ to C₈ acyl, C₁ to C₈ substituted acyl, C₁ to C₈ alkoxy, C₁ to C₈ aminoacyl, or cyclopropyl;

R₃ is C₇ to C₁₂ alkylphenyl, C₇ to C₁₂ substituted alkylphenyl, C₇ to C₁₂ substituted phenylalkyl, C₁ to C₈ aminoacyl, an ester or amide



with the following species in the reply filed on 2/22/07 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The definition for C₇ to C₁₂ alkylphenyl cannot be not found in the

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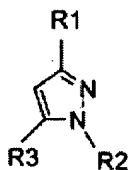
specification. A phone call was made to applicant on March 1, 2007, but did not result in further clarification.

It is noted that applicant's elected group is not similar in scope to the exemplary groups as defined in the Restriction Requirement dated 1/22/07. See for example, the definition for R₁ wherein R₁ is phenyl, substituted phenyl, naphthyl or substituted naphthyl is in a separate group from R₁ is C₅ to C₆ heteroaryl, C₅ to C₆ substituted heteroaryl. Based upon the applicant's elected species, the Examiner has endeavored to create a group of similar scope to the exemplary groups around the elected species, as stated on p. 6, of the Restriction Requirement dated 1/22/07.

Status of the Claims

Claims 1-27 are pending in this application. **Claims 5-6, 9-11, 15-17** are withdrawn from further consideration by the Examiner as being drawn to non-elected inventions under 37 CFR § 1.142(b). The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search and examination considerations. In addition, a reference that anticipates one invention would not render obvious the other invention.

The scope of the invention of the elected subject matter that has been examined is the compounds and compositions in **Claims 1-4, 7-8 and 27**, which share the same core structure shown below.



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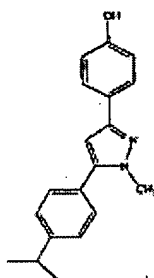
wherein R₁ is phenyl or substituted phenyl;

R₂ is H, C₁ to C₈ alkyl, C₁ to C₈ substituted alkyl, C₁ to C₈ acyl, C₁ to C₈ substituted acyl, C₁ to C₈ aminoacyl, or cyclopropyl;

R₃ is C₁ to C₈ aminoacyl, an ester or amide, C₇ to C₁₂ alkylphenyl or a phenyl substituted with R₄ and R₅ and

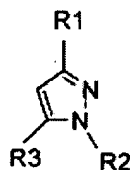
R₄ is H, C₁ to C₈ alkyl, halogen, C₁ to C₈ alkoxy, carboxy, ester, amide or C₁ to C₈ aminoacyl, and

R₅ is H, C₁ to C₈ alkyl, halogen, C₁ to C₈ alkoxy, carboxy, ester, amide or C₁ to C₈ aminoacyl.



and the corresponding species:

As a result of the election and the corresponding scope of the invention, identified supra, the remaining subject matter of **Claims 5-6, 9-11, 15-17** which are drawn to the core structure of



wherein R₁ is C₅ to C₆ heteroaryl, C₅ to C₆ substituted heteroaryl, naphthyl or substituted naphthyl;

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R₂ is C₇ to C₁₂ alkylphenyl, C₇ to C₁₂ substituted alkylphenyl, C₄ to C₈ cycloalkyl, C₄ to C₈ substituted cycloalkyl, C₅ to C₆ heteroaryl, or [C₅ to C₆]-heteroaryl -(C₁ to C₆)-alkyl; R₃ is H, C₁ to C₈ alkyl, C₁ to C₈ substituted alkyl, halogen, C₁ to C₈ alkoxy, furanyl, substituted furanyl, thiazyl, substituted thiazyl, carboxy are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to non-elected inventions.

The scope of the invention of the non-elected and non-examined subject matter includes the compounds described in the paragraph immediately above.

All compounds falling outside the search strategy of the elected compound and the structure shown above are heretofore directed to *non-elected* subject matter and are withdrawn from consideration under 35 U.S.C. § 121 and 37 C.F.R. § 1.142(b). It is suggested that in order to advance prosecution, the non-elected subject matter be canceled when responding to this Office Action.

Priority

The application is a 371 of International Application No. PCT/EP03/07066, filed on 7/02/2003, which claims the benefit of foreign priority under 35 U.S.C. 119, to European Application No. 02020256.0, filed on 09/10/2002.

Information Disclosure Statement

Applicant's Information Disclosure Statement filed on 01/20/06 has been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In In re Wands, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. § 112, first paragraph, have been described. They are:

1. the nature of the invention,
2. the state of the prior art,
3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

The nature of the invention

The nature of the invention is directed to a compound that is capable of binding the NR3B1 receptor protein or a portion thereof according to SEQ ID NO. 3 and modulating the activity of the NR3B1 receptor protein.

The state of the prior art and the predictability or lack thereof in the art

Binding a portion of the SEQ ID No. 3 of NR3B1 receptor protein has not been shown to produce an effect on humans. As stated on p. 3 of the specification, no ligands have been identified for NR3B1 to date. Very few compounds have been described that bind the NR3B1 receptor and thus show utility for treating diseases or conditions which are due to or are influenced by said nuclear receptor. Thus it cannot be concluded that these compounds have a substantial utility. It is also noted that on p. 16 of the specification the claimed compounds are said to be capable of binding the NR3B1 receptor protein or portion thereof according to SEQ ID No. 1 (ref. Fig. 3 A to D) and not SEQ ID No. 3, which is claimed. As a result, one skilled in the art clearly would not know how to use the claimed invention.

The amount of direction or guidance present and the presence or absence of working examples

The specification fails to show that the compounds can bind to NR3B1 receptor protein or a portion thereof according to SEQ ID NO. 3. As stated on p. 17 of the specification, the relevant physiological ligands of NR3B1 are unknown. It is stated that the compounds may regulate genes that participate in estrogen regulated gene networks. However, the claimed compounds are said to be capable of binding the NR3B1 receptor protein or portion thereof according to SEQ ID No. 1.

The breadth of the claims

The instant breadth of the rejected claims is broader than the disclosure, specifically, the instant claims include bind to NR3B1 receptor protein or a portion

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thereof according to SEQ ID NO. 3. The specification fails to provide evidence that the compounds bind to a portion according to SEQ ID NO. 3 of the NR3B1 receptor protein.

The quantity or experimentation needed and the level of skill in the art

It would require undue experimentation of one of ordinary skill in the art to use the compound(s) as claimed in binding the NR3B1 receptor and show utility for treating diseases or conditions which are due to or are influenced by said nuclear receptor. The lack of known physiological ligands of the NR3B1 receptor have made it difficult to ascertain what diseases can be treated by modulation of this receptor. Factors such as "sufficient working examples", "the level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method claims. In view of the breadth of the claims, the chemical nature of the invention and unpredictability of modulating protein receptors, and the lack of working examples regarding the activity as claimed, one skilled in the art would have to undergo an undue amount of experimentation to use the instantly claimed invention commensurate in cope with the claims.

Therefore, in view of the Wands factors and In re Fisher (CCPA 1970) discussed above, to practice the claimed invention herein, it is apparent that undue experimentation is necessary because of variability in prediction of outcome that is not addressed by the present application disclosure, examples, teaching and guidance presented. Absent factual data to the contrary, the amount and level of experimentation needed is undue. Therefore, claims 7-8 are rejected under 35 U.S.C. § 112, 1st paragraph.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 7-8 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-4, 7-8 and 27 recite the phrase "C₇ to C₁₂ alkylphenyl" which is not defined in the specification. It is unclear what is encompassed by this term, ie does this mean a phenyl group that can be substituted by a C₁₋₅ alkyl group or that the alkyl group is between 7 to 12 carbons without the phenyl? The term "C₇ to C₁₂ alkylphenyl" is not defined in the claims or specification so as to know the metes and bounds of the claims. Therefore, claims 1-4, 7-8 and 27 are indefinite. Applicant may overcome this rejection by pointing out where in the specification the term is defined or by deleting the undefined term.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 7-8 and 27 is rejected under 35 U.S.C. 102(b) as being anticipated by:

a) Morimoto *et al* {CA 130:52414, 1997} – see, for example, the compound of CA Registry No. 217484-45-2.

b) CA Registry No. 118880-74-3 {indexed in the Registry file on STN 2/10/89};

c) CA Registry No. 217485-60-4 {indexed in the Registry file on STN 1/21/99};

Claims 1-2, 7-8 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by:

d) Chang *et al* {CA 136:401679, 2002} – see, for example, the compound of CA Registry No. 431877-70-2;

e) CA Registry No. 287727-26-8 {indexed in the Registry file on STN 8/29/00};

f) Palkar *et al* {CA 131:271831, 1999} – see, for example, the compounds of CA Registry No. 245468-37-5 and CA Registry No. 245468-42-2;

g) CA Registry No. 131138-54-0 {indexed in the Registry file on STN 12/21/90};

h) CA Registry No. 178625-21-3 {indexed in the Registry file on STN 7/23/96};

i) CA Registry No. 152503-09-8 {indexed in the Registry file on STN 1/26/94};

j) CA Registry No. 146529-43-3 {indexed in the Registry file on STN 3/19/93};

k) Koyanagi *et al* {CA 117:171439, 1992} – see, for example, the compounds of CA Registry No. 143704-59-0;

l) Bartulin *et al* {CA 117:161422, 1992} – see, for example, the compounds of CA Registry No. 143613-60-9;

m) Johnson *et al* {CA 85:33005, 1976} – see, for example, the compounds of CA Registry No. 39784-92-4;

n) Geissler *et al* {CA 84:131323, 1975} – see, for example, the compounds of CA Registry No. 39784-92-4;

o) Johnson *et al* {CA 78:58410, 1973} – see, for example, the compounds of CA Registry No. 39784-96-8;

p) CA Registry No. 93330-77-9 {indexed in the Registry file on STN 12/18/84}.

Claims 1-3, 7-8 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by:

q) CA Registry No. 287951-36-4 {indexed in the Registry file on STN 8/31/00};

r) Stoltefuss *et al* {CA 133:150558, 2000} – see, for example, the compound of CA Registry No. 287395-67-9}.

s) CA Registry No. 38371-76-5 {indexed in the Registry file on STN 11/16/84}.

t) Ferlux in French Patent 2,104,932, 1970, see table 1 on p. 8-11.

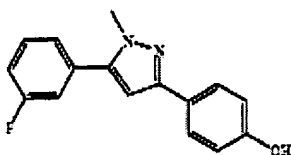
Claims 1-4, 7-8 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by:

u) CA Registry No. 75059-29-9 {indexed in the Registry file on STN 11/16/84}.

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Each of the above cited prior art disclose at least one compound that is embraced by the instant claimed invention. Therefore, each of the cited prior art anticipate the instant claimed invention.

Claims 1-4, 7-8 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Jozefiak *et al* in US Patent No. 7,119,120, see column 37, example 44.



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

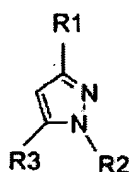
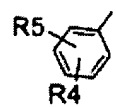
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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Claims 1-4, 7-8 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson *et al* (See Journal of Organic Chemistry, 41(1), 1976, p. 110-114), Baddar *et al* (See Journal of Heterocyclic Chemistry, 13(2), 1976, p. 258 - compound VIII k), Ishizuka *et al* (See US Pub. No. US 2004/0248950, column 54, 6th compound), Katzenellenbogen *et al* (See WO Pub No. WO 2000/19994, p. 71, 4th compound), and Frelux (See French Patent No. 2104932, p. 10, compound 14, 1972).

Applicants' instant elected invention in claims 1-4, 7-8 and 27 teach compounds

of formula I  wherein R₁ is phenyl or substituted phenyl; R₂ is H, C₁ to C₈ alkyl, C₁ to C₈ substituted alkyl, C₁ to C₈ acyl, C₁ to C₈ substituted acyl, C₁ to C₈ alkoxy, C₁ to C₈ aminoacyl, or cyclopropyl; R₃ is  (i.e. a phenyl substituted with R₄ and R₅ and

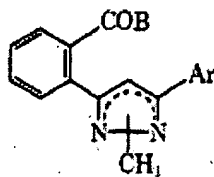
R₄ is H, C₁ to C₄ alkyl, halogen, C₁ to C₄ alkoxy, carboxy, ester, amide or C₁ to C₄ aminoacyl, and

R₅ is H, C₁ to C₄ alkyl, halogen, C₁ to C₁ alkoxy, carboxy, ester, amide or C₁ to C₄ aminoacyl.

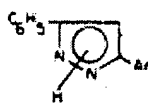
).

Determination of the scope and content of the prior art (MPEP §2141.01)

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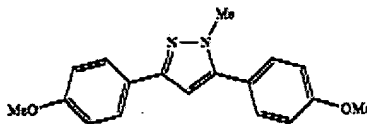
Johnson *et al* teach compound 16, 1-CH_3 ; $B = \text{OCH}_3$; $\text{Ar} = 4\text{-CH}_3\text{OC}_6\text{H}_4$ which is equivalent to applicant's invention wherein R_2 is Me, R_4 is COOCH_3 (ester), and R_1 is 4-methoxyphenyl.

Baddar *et al* teach compound

VIII

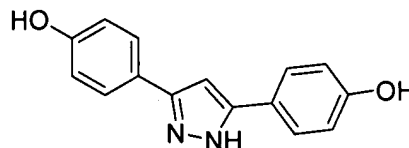
k: $\text{Ar} = p\text{-CH}_3\text{OC}_6\text{H}_4$ which is equivalent

to applicant's invention wherein R_2 is H, R_4 is H, and R_1 is 4-methoxyphenyl.

Ishizuka *et al* teach compound

which is equivalent to

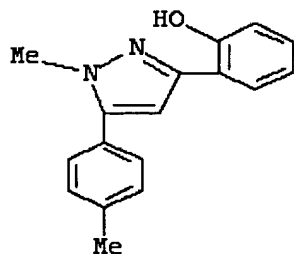
applicant's invention wherein R_2 is Me, R_4 is methoxy, and R_1 is 4-methoxyphenyl.

Katzenellenbogen *et al* teach compound

which is

equivalent to applicant's invention wherein R_2 is H, R_4 is hydroxy, and R_1 is 4-hydroxyphenyl.

The French patent of Ferlux discloses compounds, such as



which is equivalent to applicant's invention wherein R_2 is Me, R_4 is methyl, and R_1 is 2-hydroxyphenyl.

Ascertainment of the different between the prior art and the claims (MPEP §2141.02)

The difference between the prior art of Johnson *et al*, Baddar *et al*, and Ishizuka *et al* and the instantly claimed compounds is that the invention of Johnson *et al*, Baddar *et al*, and Ishizuka *et al* is directed compounds wherein the R_1 (as defined in the instant claims) represents a 4-methoxy phenyl rather than R_1 is 4-hydroxy phenyl that is claimed in the instant invention.

The difference between the prior art of Katzenellenbogen *et al* and the instantly claimed compounds is that the invention of Katzenellenbogen *et al* is directed compounds wherein the R_4 or R_5 (as defined in the instant claims) represents a hydroxy substituent rather the C_1 to C_8 alkoxy that is claimed in the instant invention.

The difference between the prior art of Ferlux and the instantly claimed compounds is that the invention of Ferlux is directed towards compounds wherein R_1 is a phenyl group is substituted with a hydroxyl group on the 2-rather than the 4-position that is claimed in the instant invention.

Finding of prima facie obviousness- rational and motivation (MPEP §2142-2143)

Johnson *et al*, Baddar *et al* and Ishizuka *et al* are analogous art because hydrogen and methyl are deemed obvious variants. See *in re Wood*, 199 USPQ 137. Substitution of a methyl for the hydrogen (i.e. methoxy for hydroxyl) on the 4-position of the phenyl ring in the R₁ position of the compounds of Johnson *et al*, Baddar *et al*, and Ishizuka *et al* or substitution of a hydrogen for the methyl (i.e. hydroxy for methoxy) in the R₄ or R₅ position of the compounds of Katzenellenbogen *et al* would give rise to the compounds of the instant claims. Adjacent homologues and structural isomers are generally so structurally similar that “without more” such structural similarity could give rise to prima facie obviousness. In *re Wilder*, 563 F.2d 457, 195 USPQ 426. The compound of Ferlux is analogous art since nothing unobvious is seen in substituting the known claimed isomer for the structurally similar isomer as taught by Ferlux, since such structurally related compounds suggest one another and would be expected to share common properties absent a showing of unexpected results. In *re Norris*, 84 USPQ 458 (1950). These compounds are disclosed to have pharmacological uses as anti-inflammatory and sedatives.

In the absence of unexpected results, one skilled in the art would expect that the instant claims which are compounds that are analogous to the compounds of Johnson *et al*, Baddar *et al* and Ishizuka *et al* (i.e. adjacent homologues such as where R₁ is a phenyl substituted with Me), the compounds of Katzenellenbogen *et al*, where R₄ is hydroxyl rather than methoxy, and the compound of Ferlux where R₁ is a phenyl substituted with a hydroxyl at the 2-position rather than the 4-position is prima facie.

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One would have been motivated to make the claimed compounds since it is widely known that the synthesis of pyrazoles is of great interest due to the wide applications of such heterocycles in the pharmaceutical and agrochemical industry (see Aggarwal *et al*, Journal of Organic Chemistry, 68(13), 2003). The compounds of Johnson *et al*, Baddar *et al*, Ishizuka *et al*, Katzenellenbogen *et al* and Ferlux all fall within these categories and are suggested within the teachings. The explicit teaching of Johnson *et al*, Baddar *et al*, Ishizuka *et al*, Katzenellenbogen *et al* and Ferlux together with the enabled examples would have motivated one skilled in the art to make the known compounds in order to synthesize other useful compounds. Therefore claims 1-4, 7-8 and 27 are rejected under 35 U.S.C. 103(a).

Claim Objections

Claims 7 and 8 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). A compound's intended use does not further limit the claim. These objections can be overcome by deleting the duplicate claims.

Claims 1-4, 7-8 and 27 are objected to because of the following informalities: it is dependent on subject matter that has been withdrawn from consideration. Appropriate correction is required.

Objections: Specification

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Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In the instant application, the abstract contains the language "said."

Appropriate correction is required.

Conclusion


The elected species appears allowable over the prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cheng whose telephone number is 571-272-6233. The examiner can normally be reached on M-F, 9AM to 5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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